

REMARKS

In the Final Office Action mailed August 20, 2008, claims 1, 3-19, 22-27, 29-40, 49-51 and 53-57 were pending. Claims 1, 3-4, 9, 11-14, 16-19, 22, 23, 26, 27, 29, 30, 32, 37-40 and 49-51 were rejected, and claims 5-8, 10, 15, 24, 25, 31, 33-36 and 53-57 were objected to but indicated to be allowable if rewritten in independent form incorporating the base claim and any intervening claims. Reconsideration of the final rejection and allowance of the subject application are hereby requested.

Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,677,798 to Phillips. Claim 1 recites features that each of the guide members includes "opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides." The Final Office Action asserts that elements (a) and (b) are guide members extending distally from frame 44 in Figure 5. However, the flange of element (a) and the flange of element (b) do not extend along a side of the respective element (a) and element (b) that extends from the proximal end to the distal end of the respective element (a) and (b). Rather, the flange extends transversely to the proximal and distal directions. Therefore, claim 1 is not anticipated by Phillips and withdrawal of the rejection of claim 1 is respectfully requested. Claim 9 depends from claim 1 and distinguishes Phillips at least for the reasons claim 1 does.

Claims 38, 39, and 49-51 stand rejected under 35 USC §102(b) as anticipated by DE 297 03 850. Claim 38 recites, among other features, "said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members, said guide surfaces being generally parallel with one another; and a proximal portion including a frame coupled to said first and second guide members, said frame being structured to move said first and second guide members toward and away from one another with said guide surfaces remaining generally parallel...." DE 297 03 850, in contrast, discloses members that include facing surfaces that are concavely curved from one side of the member to the other side of the member, and thus are not generally parallel. Therefore, withdrawal of the basis of the rejection of claim 38 along with claim 39 depending therefrom is respectfully

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 12 of 17

requested.

Claim 49 recites, among other features, "said first and second guide members each including: opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides and being oriented toward the guide surface of the other of said first and second guide members; and a width between said first and second sides, said width being greater than a width of an implant to be positioned along said guide surfaces." The Office Action does not indicate how DE 297 03 850 discloses that the width between the sides of the facing surfaces of the members is greater than a width of an implant to be positioned along the facing surfaces. Therefore, a *prima facie* case for rejecting claim 49 as anticipated by DE 297 03 850 has not been established, and withdrawal of this basis of the rejection of claim 49 is respectfully requested.

Claim 50 recites, among other features, "wherein each of said first and second guide members include a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members." The Office Action does not indicate how DE 297 03 850 is considered to disclose the only one guide flange of each of the guide members arranged in the manner recited in claim 50. Therefore, a *prima facie* case for rejecting claim 50 is not established, and withdrawal of this basis of the rejection of claim 50 along with claim 51 depending therefrom is respectfully requested.

Claims 1, 9, 11-14, 16-19, 26, 29, 30, 32, 37-40 and 49-51 stand rejected under 35 USC §102(e) as anticipated by U.S. Patent No. 6,599,294 to Fuss. Fuss discloses an instrument 1 with two arms 3, 4 which are substantially identical in construction. See col. 4, lines 40-44. Each arm includes a flat guide body 5, and the two guide bodies 5 are U-shaped in cross-section and comprise a mutually opposing flat guide surface 10 laterally delimited by side walls 11 which extend the entire length of guide surface 10 and project in the direction of the other guide body. The two guide bodies 5 form between them a guideway delimited at the top and underside by the two guide surfaces 10 and at the sides by the side walls 11, where each guide body 5 includes a pair of side walls 11. See col. 4, lines 58-67 and Figures 1-3.

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 13 of 17

In contrast, claim 1 recites that each guide member includes "opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members." Since Fuss fails to disclose the guide member with only one guide flange extending therealong as recited in claim 1, it cannot anticipate claim 1 and withdrawal of this basis of the rejection of claim 1 is respectfully requested.

Claims 9, 12-14 and 16-18 depend directly or indirectly from claim 1 and distinguish Fuss at least for the reasons claim 1 does and for other reasons. For example, Fuss discloses that arms 3, 4 each pivot about joint 7, and therefore does not disclose the stationary arm and movable arm recited in claim 12. Since arms 3, 4 are pivotally coupled at joint 7, and when guide bodies 5 are moved relative to one another, guide bodies 5 move about joint 7 in non-parallel relation. Therefore, Fuss cannot anticipate claim 18. Withdrawal of this basis of the rejection of claims 9, 12-14, and 16-18 depending from claim 1 is respectfully requested.

Claim 11 recites, among other features, that each of the guide members "opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members." As discussed above with respect to claim 1, Fuss does not disclose guide member with a guide flange extending along only one side thereof, it cannot anticipate claim 11.

Claim 19 recites that each guide member includes "opposite first and second sides extending between a proximal end and a distal end, wherein said proximal ends are coupled to respective ones of said stationary arm and said movable arm; said guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 14 of 17

surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members, wherein when said guide surfaces are facing one another said guide flanges are opposite each other along a length of said guide members".

As discussed above with respect to claim 1, Fuss does not disclose a guide member with a guide flange extending along only one of the sides of the guide member, thus it does not anticipate claim 19.

Claims 26, 29, 30, 32, and 37 depend directly or indirectly from claim 19 and distinguish Fuss at least for the reasons claim 19 does and for other reasons. For example, Fuss discloses that arms 3, 4 are pivotally coupled at joint 7, and when guide bodies 5 are moved relative to one another, guide bodies 5 move about joint 7 in non-parallel relation. Therefore, Fuss cannot anticipate claim 37. Withdrawal of the rejection of claims 26, 29, 30, 32 and 37 depending from claim 19 is respectfully requested.

Claim 38 recites "a distal portion including a first guide member and a second guide member extending along said first guide member, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members...." Furthermore, claim 38 recites "a proximal portion including a frame coupled to said first and second guide members, said frame being structured to move said first and second guide members toward and away from one another with said guide surfaces remaining generally parallel...." Fuss discloses that arms 3, 4 are pivotally coupled at joint 7, and when guide bodies 5 are moved relative to one another, guide bodies 5 move about joint 7 in non-parallel relation. Therefore, Fuss cannot anticipate claim 38.

Claims 39 and 40 depend from claim 38 and also are not anticipated by Fuss since Fuss fails to disclose a stationary arm coupled to one of the guide bodies as recited in claim 39, nor does it disclose the guide member with a single guide flange recited in claim 40. Withdrawal of this basis of the rejection of claims 39 and 40 is respectfully requested.

Claim 49 recites "a distal portion including a first guide member extending distally from said first arm and a second guide member extending distally from said second arm, said first and second guide members being movable toward and away from one another by moving said first arm relative to said second arm" As discussed above, Fuss discloses arms 3, 4 secured to one

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 15 of 17

another about a pivot joint 7, and guide bodies 5 are moved by moving arms 3, 4 together about pivot joint 7. Therefore, Fuss does not anticipate claim 49.

Claim 50 recites "wherein each of said first and second guide members include a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members." As discussed above with respect to claim 1, Fuss fails to disclose that guide bodies 5 include only one guide flange. Therefore, Fuss cannot anticipate claim 50 and withdrawal of this basis of the rejection of claim 50 is respectfully requested.

Claim 51 depends from claim 50 and distinguishes Fuss at least for the reasons claim 50 does, and also for the reasons claim 39 does as discussed above. Withdrawal of this basis of the rejection of claim 51 is respectfully requested.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 297 03 850 in view of U.S. Patent App. Pub. No. 2004/0024291 to Zinkel. Claim 27 recites "a distal portion including a first guide member extending distally from said movable arm and a second guide member extending distally from said stationary arm, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members, said first and second guide members being movable toward and away from one another by moving said movable arm relative to said stationary arm while maintaining said guide surfaces in parallel relation...." As discussed above, DE 297 03 850 discloses members with facing surfaces that are concavely curved from one side to the other side, and thus the surfaces are not in parallel relation. Furthermore, Zinkel teaches non-parallel movement of facing surfaces of the retractor disclosed therein. Therefore, claim 27 is allowable and withdrawal of the rejection of the same is respectfully requested.

Claims 3, 4, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuss in view of U.S. Patent No. 5,431,658 to Moskovich. Claims 3 and 4 depend directly or indirectly from claim 1, and claims 22 and 23 depend directly or indirectly from claim 19. These claims are allowable at least for the reasons their respective base claims are allowable, and withdrawal of the rejection of claims 3, 4, 22 and 23 is respectfully requested.

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 16 of 17

Best Available Copy

10/20/2008 11:45 FAX

KRIEG DEVAULT

019

It is respectfully submitted that the present application including claims 1, 3-19, 22-27, 29-40, 49-51 and 53-57 is in condition for allowance. Reconsideration of the present application in view of the foregoing remarks is respectfully requested. The Examiner is welcome to contact the undersigned to resolve any outstanding issues with regard to the present application.

Respectfully submitted,

By:



Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
(317) 238-6333 voice

Response to Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 17 of 17